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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,216	05/30/2000	Lou Leonardo	003801.P021	2363

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/583,216

Applicant(s)

LEONARDO ET AL

Examiner

Vanel Frenel

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed response: a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-20.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


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Continuation of 5:

Note: Applicant's request for consideration does not place the application in condition for allowance because: Applicant's remarks fail to consider the full teachings of the applied references in the manner discussed in the prior Office Action.

Applicant's arguments filed on 12/20/03 with respect to claims 1-20 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed on 12/20/03.

(A) At pages 6-11 of the 12/20/03 response, Applicant's argues the followings:

(1) The Office Action introduces a new ground of rejection that is neither necessitated by an Applicants' amendment of the claims nor based on information submitted in an information disclosure statement. (See MPEP, Section 706.07 (a)). Specifically, in reply to Applicants response mailed August 7, 2003 that Fisher does not disclose nor suggest "facilitating a resolution of the complaint associated with the identifier", as claimed, the Office Action, page 10, section C). Accordingly, Applicants respectfully submit that this final rejection is premature under MPEP, Section 706.07 (a) and respectfully request reconsideration and withdrawal of the finality of the Office Action.

(2) Campbell does not explicitly disclose nor suggest "facilitating a resolution of the complaint associated with the identifier".

(3) Fisher and Campbell do not render claim 1 obvious. Applicants request the rejection to claims 1, 10 and 19 be withdrawn as well as their dependent claims.

(B) With respect to Applicant's argument that a new grounds of rejection was presented in the last Office Action, the Examiner maintains that No new ground of rejection was applied in the Final Rejection mailed 10/10/03 (Paper No.9). In particular, the basis of rejection in Both the first Office Action mailed 04/14/03 (Paper No.7) and the Final Rejection of 10/10/03 (Paper No.9) was the collective teachings of Fisher (5,835,896) in view of Campbell (2001/0041993). Note pp.2-13 of Paper No.9 and pp.2-9 of Paper No.7 which set forth the applicable rejections. Applicant's points out to page 6 of the Final Rejection as "New grounds of Rejection. However, the passages referred to by Applicant are merely responses to Applicant's arguments to provide further support for the rejections based on Fisher and Campbell, and as such, do not constitute a "new grounds of rejections". Further, as noted above, there was no new grounds of rejection made in the Final Rejection of 10/10/03. As such, it is respectfully submitted that the Final Rejection mailed 10/10/03 is indeed proper, and hereby maintained.

(C) Examiner respectfully suggests Campbell discloses "An attorney that wishes to "bid" on unresolved insurance claims must be registered on the legal server 102. The attorney, using the attorney computer 118, establishes communication with the legal server 102 via the communication network 116 using the network browser. Once the attorney establishes communication with the legal server 102, the login module 312 presents the attorney with a login display. If the attorney has previously registered, the attorney can log onto the legal server 102 and participate in the claim auctioning process. If the attorney has not previously registered, the attorney registration module 310 prompts the attorney for registration information, confirms the attorney's identity, and approves the attorney's registration. Thereafter, the attorney is able to log onto the legal server 102 and participate in the claim auctioning process" which correspond to Applicant's claimed feature (See Campbell, Col.5, Paragraph 0046). Therefore, Applicant's argument is not persuasive.

(D) Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 7). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive. Others arguments presented appear to rehash issues addressed in the Final Rejection of the 10/10/03.